

REMARKS

Claim 1 has been amended to limit the total number of PFPE (perfluoropolyether) units, as defined in formula (1), to not less than 10. Support is found bridging pages 17-18 of the specification.

Review and reconsideration on the merits are requested.

Claims 1 and 4-6 were rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,021,527 to Ohmori et al or its EP equivalent. Ohmori et al was cited as disclosing the claimed curable surface modifier, with exception of a number of PFPE units of from 7 to 40. In view of the Remarks portion of Applicants' Amendment filed June 8, 2009, the Examiner cited Ohmori et al as disclosing a maximum total number of PFPE units of at most 6. Because Ohmori et al is said to disclose a substantially identical fluorine-containing resin comprising a substantially (number of) identical PFPE side chains, the Examiner considered that the prior art composition would inherently possess the same properties as the claimed curable surface modifier.

The rejection should be withdrawn because Ohmori et al does not disclose or otherwise suggest a total number of PFPE units, as defined in formula (1), of not less than 10 as required by amended claim 1. Further, there is no apparent reason which would lead one of ordinary skill to increase the total number of PFPE units to a number of not less than 10 because Ohmori et al specifically instructs that the total number of PFPE units within the scope of formula (1) of claim 1 should not exceed 5. See claim 2 and the description bridging cols. 4-5 of Ohmori et al. This is discussed in further detail below.

In the present invention, the total number of PFPE recurring units, as defined in formula (1), is limited to not less than 10, thereby making it possible to exhibit more excellent sliding

property and improved stain-proofing property, particularity removability of stains containing an oily component (page 17, line 27-page 18, line 4 of the specification).

In contrast, Ohmori et al limits and specifically instructs that the total number of PFPE recurring units is not to exceed 5 (claim 2 in the specification bridging cols. 4-5 of Ohmori et al).

Namely, the perfluoropolyether (PFPE) (=Rf) of the (meth)acrylate monomer (4) of Ohmori et al is represented by the formula: $-(\text{CF}_2\text{CF}_2)_m(\text{O})_n\text{CF}(\text{R}^f)\text{CF}_3$

wherein m is an integer of from 0 to 5, n is an integer of from 1 to 5, n is 0 or 1, q is an integer of from 1 to 5, and R^f is a fluorine atom or trifluoromethyl,

or the formula:



wherein p is an integer of from 0 to 5, and R^f is defined above.

In the formula: $-(\text{CF}_2\text{CF}_2)_m(\text{O})_n\text{CF}(\text{R}^f)\text{CF}_3$, the total number of the PFPE units, i.e. $-\text{CF}_2\text{CF}_2\text{O}-$ units is at most 5 ($q=5$). In the formula: $-\text{CF}(\text{CF}_3)\text{O}(\text{CF}_2\text{CF}(\text{CF}_3)\text{O})_p\text{CF}(\text{R}^f)\text{CF}_3$, the total number of the PFPE units, i.e., $-\text{CF}(\text{CF}_3)\text{O}-$ and $-(\text{CF}_2\text{CF}(\text{CF}_3)\text{O})-$ units, is at most 6 ($p=5$). However, the unit $-(\text{CF}_2\text{CF}(\text{CF}_3)\text{O})-$ is not within the scope of the polyfluoropolyether chains P represented by the formula (1) of the present invention, such that the total number of PFPE units in this second formula within the scope of present claim 1 is one (1).

Thus, the total number of perfluoroether units in Ohmori et al within the scope of present claim 1 is at most 5, and does not satisfy the definition according to present claim 1, i.e., an integer of not less than 10. Further because the polymer of Ohmori et al has a structure that is different from that of the polymer (IAB) of present claim 1, Ohmori et al does not anticipate the present claims. Further, because Ohmori et al limits the total number of perfluoroether units within the scope of present claim 1 to at most 5, there is no apparent reason which would lead one

of ordinary skill to employ a total number of not less than 10 as required by the amended claims.

Thus, the present claims are also unobvious over Ohmori et al.

Withdrawal of the foregoing rejection and allowance of claims 1 and 4-6 is earnestly solicited.

In the event that the Examiner believes that it may be helpful to advance the prosecution of this application, the Examiner is invited to contact the undersigned at the local Washington, D.C. telephone number indicated below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Abraham J. Rosner
Registration No. 33,276

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: February 25, 2010